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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/606,508 | 06/26/2003 | James J. Bernas | SP03-073 | 5198 |

22928 7590 10/17/2005
CORNING INCORPORATED
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CORNING, NY 14831

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| EXAMINER |
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DEL SOLE, JOSEPH S

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| ART UNIT | PAPER NUMBER |
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1722

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,508

Applicant(s)

BERNAS ET AL.

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-28, 39, 40, 42, 43, 45 and 46 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-31, 33, 34 and 37 is/are allowed.
- 6) ☒ Claim(s) 32, 35, 36 and 38 is/are rejected.
- 7) ☒ Claim(s) 41 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/4/03, 9/2/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 1-28, 39, 40, 42, 45 and 46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected product and or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/2/05.

Specification

2. The disclosure is objected to because of the following informalities: **a)** the title currently refers to both the product and the apparatus for making, since only apparatus is claimed the Examiner suggests changing the title to: -- Extrusion Die for Making a Double-Skin Honeycomb Substrate --; and **b)** at line 3 of page 14 "forming die 802" should be changed to --forming die 804 --.

Appropriate correction is required.

Claim Objections

3. Claims 41 and 44 are objected to because of the following informalities: **a)** claims 41 and 44 are dependent on withdrawn claims. Appropriate correction is required. The Examiner directs the Applicant's attention to the "Allowable Subject Matter" section below; should claim 29 remain unchanged and should only the below errors be corrected, claim 39-40, 42-43 and 45-46 may be rejoined. In which case, claims 41 and 44 need not be amended.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 32 and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 32 lacks sufficient written description because no structure is set forth in the claims or the specification that enable the volume of the outer skin reservoir to be adjustable. The Examiner notes that the assembled die assembly of the claims and the specification lacks moving parts for adjustability.

Claim 35 (and therefore dependent claim 36) lacks sufficient written description because no structure is set forth in the claims or the specification that enable the volume of the inner skin reservoir to be adjustable. The Examiner notes that the assembled die assembly of the claims and the specification lacks moving parts for adjustability.

6. Claims 32 and 35-36 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

Art Unit: 1722

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 32 lacks enablement because no structure is set forth in the claims or the specification that enable the volume of the outer skin reservoir to be adjustable. The Examiner notes that the assembled die assembly of the claims and the specification lacks moving parts for adjustability.

Claim 35 (and therefore dependent claim 36) lacks enablement because no structure is set forth in the claims or the specification that enable the volume of the inner skin reservoir to be adjustable. The Examiner notes that the assembled die assembly of the claims and the specification lacks moving parts for adjustability.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 32, 35-36 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 is vague and indefinite because it is unclear how to adjust the volume of the outer skin reservoir.

Claim 35 is vague and indefinite because it is unclear how to adjust the volume of the outer skin reservoir.

Claim 38 is vague and indefinite because the term "outboard" does not clearly set forth the structural relationship between the orifices and the outer slots. The Examiner notes that "outboard" is not defined in the specification.

Allowable Subject Matter

9. Claims 29-31, 33-34 and 37 are allowed.
10. Claim 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. Claims 41 and 44 would be allowable if their dependency were changed to a dependence on a non-withdrawn parent claim. However, the Examiner notes that should claim 29 remain unchanged, and should only the above errors be corrected, claim 39-40, 42-43 and 45-46 may be rejoined. In which case, claims 41 and 44 need not be amended.

References of Interest

12. Frost (4,298,328), Beall et al (6,455,124), Cocchetto et al (5,256,054), Miyazaki (6,287,103), Kragle (5,089,203), Gangeme et al (4,915,612), Shibagaki et al (6,854,969), Kodama et al (5,942,260), Miura et al (5,906,839) and Bagley (3,905,743) are cited of interest to show the state of the art and also the closest prior art. The Examiner notes that none of these show an extrusion die having an inner cell forming die, a skin forming mask, an outer cell forming die between the inner cell forming die and forming mask and with the outer skin slot being in communication with the peripheral feedholes through an opening in the outer cell forming die.

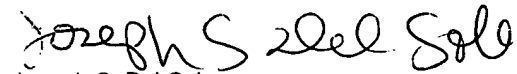
Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

Art Unit: 1722

If attempts to reach the Examiner by telephone are unsuccessful, Mr. Duane Smith can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).



Joseph S. Del Sole
October 12, 2005